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10/024,121	12/18/2001	Lauri Soderbacka	810-010767-US(PAR)	3543

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EXAMINER

SMITH, SHEILA B

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,121

Applicant(s)

SODERBACKA ET AL.

Examiner

Sheila B. Smith

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 33 is/are allowed.
- 6) ☐ Claim(s) 1-32,34 is/are rejected.
- 7) ☐ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-5,7-13,15, 17-32,34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne (U. S. Patent Number 5,737,703) in view of Huang et al. (U. S. Patent Number 6,041,358).

Regarding claims 1,34, Byrne discloses all the claimed invention as set fourth in the instant application, also Byrne discloses a multi-mode radio telephone which executes handover between different system, in addition Byrne discloses a method for performing an intersystem handover of a mobile terminal (401) accessing a communication network via a radio access network of a first type (which reads on GSM), wherein said communication network comprises at least said radio access network (GSM) of said first type and a radio access network (DECT) of a second type, and wherein said intersystem handover is initiated by a transmission of said mobile terminal to said communication network (which reads on column 6 lines 45-60), which transmission comprises information indicating that an intersystem handover from said radio access network of said first type to said radio access network of said second type should be performed (which reads on column 7 lines 50-60). However Byrne fails to disclose the information is based on a requested internet protocol (IP) address.

In the same field of endeavor, Huang et al. further discloses a method for maintaining virtual local area networks with mobile terminals in an atm network. In addition Huang et al. disclose the information is based on a requested internet protocol (IP) address as (disclosed in column 3 lines 35-40).

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify Byrne by specifically providing for the information is based on a requested internet protocol (IP) address for the purpose of having the mobile providing packet communication.

Regarding claim 2, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses said information indicating that an intersystem handover should be performed is a direct request for a specific type of radio access network (which reads on column 8 lines 30-35).

Regarding claims 3, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses said mobile terminal stores a list with at least one preferred type of radio access network, from which list said specific type of radio access network is selected (which reads on column 8 lines 30-35).

Regarding claims 4, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses at least one preferred type of radio access network is assigned to a specific type of content or service or to specific characteristics of contents or services, and wherein said specific type of radio access network is selected based on a desired content or service (which reads on column 8 lines 30-35).

Regarding claims 5, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses said information indicating that an intersystem handover should be performed enables said communication network to derive a type of radio access network to which said mobile terminal should be connected (which reads on column 8 lines 20-30).

Regarding claims 7, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses for deriving said type of radio access network to which said mobile terminal should be connected based on said information indicating that an intersystem handover should be performed, said communication network comprises a network element storing a list with at least one preferred type of radio access network for said mobile terminal (which reads on column 8 lines 35-37).

Regarding claims 8, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses said information indicating that an intersystem handover should be performed is transmitted in a dedicated information element in a connection establishment signaling (which reads on column 8 lines 30-35).

Regarding claims 9, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses said information indicating that an intersystem handover should be performed is transmitted in a dedicated message of a connection establishment signaling (which reads on column 8 lines 50-55).

Regarding claims 10, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses said radio access network of said first type is a preferred type of radio access network of said mobile terminal due to a first criterion,

Art Unit: 2681

and wherein said radio access network of said second type is a preferred type of radio access network of said mobile terminal due to a second criterion (which reads on column 8 lines 47-60).

Regarding claims 11, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses an intersystem handover is required whenever a requested content is only available from a specific operator via said second type of radio access network (which reads on column 8 lines 30-35).

Regarding claims 12. Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses said mobile terminal different access point names are assigned to different contents, which contents are available via different types of radio access network, and wherein said information indicating that an intersystem handover should be performed comprises the access point name assigned to a requested content (which reads on column 8 lines 30-35).

Regarding claims 13. Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses communication network stores a list for said mobile terminal, in which list different access point names are assigned to a respective type of a radio access network, and wherein said communication network selects a type of radio access network to which a handover is to be performed from said list based on said access point name received in said information indicating that an intersystem handover should be performed from said mobile terminal (which reads on column 8 lines 30-35).

Regarding claims 15. Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses an intersystem handover should be

performed whenever said second type of radio access network is required for a specific service (which reads on column 6 lines 1-9).

Regarding claims 17. Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses information indicating that an intersystem handover should be performed is transmitted by said mobile terminal in a setup message to said communication network (which reads on column 7 lines 50-55).

Regarding claims 18. Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses communication network grants an intersystem handover initiated by a transmission of said mobile terminal or, in case said intersystem handover is not feasible, blocks a requested call or context activation for which said intersystem handover was initiated (which reads on column 8 lines 30-35).

Regarding claims 19. Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses said communication network triggers a handover with a new information element to said first type radio access network (which reads on column 8 lines 5-15).

Regarding claims 20, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses said intersystem handover takes place at a call setup (which reads on column 7 lines 50-55).

Regarding claims 21. Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses, wherein said intersystem handover takes place at a packet data protocol (PDP) context activation (which reads on column 8 lines 30-35).

Regarding claims 22-26, Byrne discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses means for accessing a communication network via at least two different types of radio access networks, and transmitting means for transmitting an information indicating that an intersystem handover from a radio access networks of a first type of said communication network to a radio access network of a second type of said communication network should be performed (which reads on column 7 lines 50-60). However Byrne fails to disclose the information is based on a requested internet protocol (IP) address.

In the same field of endeavor, Huang et al. further discloses a method for maintaining virtual local area networks with mobile terminals in an atm network. In addition Huang et al. disclose the information is based on a requested internet protocol (IP) address as (disclosed in column 3 lines 35-40).

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify Byrne by specifically providing for the information is based on a requested internet protocol (IP) address for the purpose of having the mobile providing packet communication.

Regarding claims 27, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claim 26) in addition, Byrne discloses comprising storing means for storing for a mobile terminal a list with at least one preferred type of radio access network and selection means for selecting from said list one type of radio access network according to information indicating that an intersystem handover should be performed received from said mobile terminal, and wherein said means for performing an intersystem handover perform said handover in case

Art Unit: 2681

the mobile terminal is currently accessing said communication network via another type of radio access network than the selected type of radio access network (which reads on column 3 lines 56-67).

Regarding claims 28, 32. Byrne discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses core network with a network element, which network element includes means for analyzing information indicating that an intersystem handover should be performed received by a mobile terminal in order to determine a type of radio access network to which said mobile terminal should be connected, and means for triggering an intersystem handover in the radio access network to which the mobile terminal is currently connected (which reads on column 8 lines 30-35). However Byrne fails to disclose the information is based on a requested internet protocol (IP) address.

In the same field of endeavor, Huang et al. further discloses a method for maintaining virtual local area networks with mobile terminals in an atm network. In addition Huang et al. disclose the information is based on a requested internet protocol (IP) address as (disclosed in column 3 lines 35-40).

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify Byrne by specifically providing for the information is based on a requested internet protocol (IP) address for the purpose of having the mobile providing packet communication.

Regarding claims 29, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses at least one radio access network of

Art Unit: 2681

said communication network comprises means for performing an intersystem handover to a radio access network of another type of said communication network based on a request by a network element of a core network of said communication network (which reads on column 3 lines 50-67).

Regarding claims 30, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses said radio access network of said first type is a 3G (3rd generation) radio access network, and wherein said radio access network of said second type is a 2G (2nd generation) radio access network (which reads on column 1 lines 35-45).

Regarding claim 31, Byrne in view of Huang et al. discloses everything claimed, as applied above (see claims 1) in addition, Byrne discloses said radio access network of said first type is a WCDMA (wideband code division multiple access) radio access network, and wherein said radio access network of said second type is a GSM/GPRS (global system for mobile communications / general packet radio system) radio access network (which reads on column 7 lines 50-60).

Allowable Subject Matter

1. Claim 33 is allowed.
2. Claim 35 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

3. Applicant's arguments filed 11/25/09 have been fully considered but they are not persuasive.
4. Regarding applicants arguments that the prior art fails to disclose that the intersystem handover is initiated by a transmission of the mobile terminal the examiner contends that the use of mobile assisted soft handoff is well know in the art and it would have been obvious for Byrne to use.
5. Regarding applicants arguments that the Huang is deficient in disclosing that a handover upon transmission of information that is based on an IP address, the examiner contends that Huang discloses "At the network layer, all of the nodes may communicate using the same protocol, e.g., the internet protocol or IP. Like the Ethernet protocol, each node that can serve as a source or destination node is assigned a unique IP identifier or IP address. Information is transmitted from a source node to a destination node in a bitstream that is organized into packets. Each packet has a header and a payload. The IP address of the source node is written in a source field of the packet header and the IP address of the destination node is written in a destination field of the packet header. The data is then written in the payload. The packet is then transmitted according to the appropriate data-link layer protocol for the network (e.g., formed into MAC frames, divided into ATM cells, etc.) and then transmitted to its respective destination node. IP provides a routing function for routing a packet from node to node in a sequence of nodes until the packet arrives at its destinations using routing tables that are similar to the ATM cell routing tables." Which reads on that limitation.
6. The examiner stands by and restate the above rejection.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheila B. Smith whose telephone number is (571)272-7847. The examiner can normally be reached on Monday-Thursday 6:00 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Smith

March 20, 2006



TEMICA BEAMER
PRIMARY EXAMINER

3/20/06